

## **II. REMARKS**

### **A. STATUS**

In this reissue application, claims 1-17 and 19-35 are pending.

Applicants respectfully note that as claims 1-9 are not addressed at all in the Office Action's rejections. Moreover, claims 21 and 26 are not addressed with respect to §§102-103 rejections. As the status of claims 1-9, 21, and 26 are unclear with respect to §102 and §103, claims 1-9 are thus apparently allowed and claims 21 and 26 are thus apparently allowable.

Claims 10-17 and 19-35 stand rejected as being based on a defective reissue Oath.

Claims 10-17 and 19-35 stand rejected as further being improperly broadened in a reissue application sworn by the assignee and not the patentee.

Claims 10-17 and 19-23 stand rejected under 35 USC § 112 for use of the word "through" and other elements identified by the Patent Examiner.

Claims 16-17, 20, 22-25, 28, 30, 33-35 stand rejected under 35 USC §102(a) and/or 35 USC §102(b) as being anticipated by US Patent 5,383,829 to Miller ("Miller I") and/or US Patent 5,242,343 to Miller ("Miller II") (collectively, "Miller").

Claims 33-34 stand rejected under 35 USC §103(a) as being rendered obvious by either Miller I or Miller II in view of Breunig.

Claims 27, 29, 31, and 32 are objected to.

### **B. The Oath Is Not Defective**

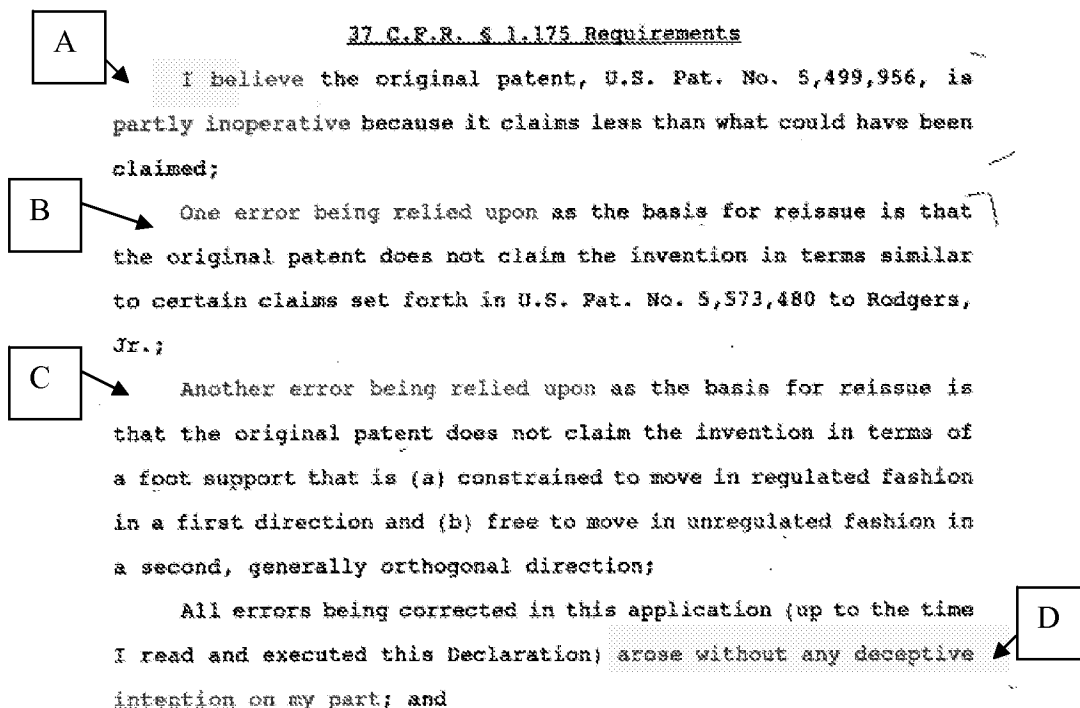
In the present Office Action (June 19, 2007), the Patent Examiner proffers the following five different reasons for why the reissue declaration is allegedly defective:

1. it lacks a statement that the applicant believes that the original patent was wholly or partially inoperative or invalid
2. it fails to identify at least one error which is relied upon to support the reissue

3. the error upon which the applicant relies cannot support a reissue application
4. the applicant's stated error is not present in the claims presented
5. the requisite statement of lack of deceptive intent is missing

(Office Action, pages 3-4). Applicants respectfully traverse.

A substitute declaration was submitted in May 1998. (File History, Doc. 4) A true and correct copy of portion of the substitute declaration is reproduced below with highlighting and callouts added for clarity:



(File History, Doc. 4, page 2).

Section 1.175 of title 37 of the current Code of Federal Regulations governs the examination of reissue applications. Rule 1.175 changed in 1997 during the pendency of this reissue application. The prior Rule 1.175 used to require that a reissue declaration include the following information:

- (1) When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reasons why.
- (2) When it is claimed that such patent is inoperative or invalid “by reason of a defective specification or drawing,” particularly specifying such defects.
- (3) When it is claimed that such patent is inoperative or invalid “by reason of the patentee claiming more or less than he had the right to claim in the patent,” distinctly specifying the excess or insufficiency in the claims.

\* \* \*

- (5) Particularly specifying the errors relied upon, and how they arose or occurred.
- (6) Stating that said errors arose “without any deceptive intention” on the part of the applicant.

This is no longer the case.

Although the old Rule 1.175 required a reissue declaration “explaining the source of [every] error, that it was non-deceptive and otherwise excusable, and how the amendment corrects the [error],” the new rule has no such requirement. *Shockley v. Arcan, Inc.*, 248 F.3d 1349, 1358 (Fed. Cir. 2001), *citing* 35 U.S.C. § 251 (1994). The new rule 1.175, effective December 1, 1997, requires the patentee to disclose only a single error for correction and to include only a general statement that the errors involved no deceptive intent. *Id. citing* 37 C.F.R. § 1.175(a) (1997). The present reissue application’s oath or declaration is to be evaluated under the new rule 1.175, not the old one. *Id.* at 1358-59. With this in mind, Applicants respectfully traverse the Patent Examiner’s rejection of the substitute declaration.

On page 3 of the Office Action, the Patent Examiner asserts that the declaration fails to contain the requisite statement as to the applicant’s belief. (Office Action, page 3, ¶ 2) Applicants respectfully traverse. The required statement is shown above at callout “A” on page 11 of this Response. Thus, the substitute declaration contains the requisite statement as to the applicant’s belief.

On page 3 of the Office Action, the Patent Examiner asserts that the declaration fails to identify at least one error on which the reissue application relies. (Office Action, page 3, ¶ 3) Applicants respectfully traverse. Two such statements are shown above at callouts “B” and “C” on the page 11 of this Response. Applicants further respectfully note that the new Rule 1.175(c) states that “Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.” Thus, the substitute declaration contains the requisite statement as to errors.

On page 3 of the Office Action, the Patent Examiner asserts that the declaration fails because the errors cited are not errors upon which the reissue application can be based. (Office Action, page 3, ¶ 4) The Patent Examiner further asserts that these stated errors are not present in the claims presented. (Office Action, page 4) Applicants respectfully traverse.

The declaration identifies two errors on which the reissue application can be based, shown above at callouts “B” and “C” on page 11 of this Response. For example, claims 13 and 19 were amended to add a “foot support” term to its limitations. (See callout “C” above) Thus, these two claims had an error present in the claims presented upon which the applicants relied to support the reissue application as identified in the declaration. Claims 16, 28, and 29, amended to support an interference, had terms added that correspond to Rodgers. (See callout “B” on page 11 of this Response). All these errors support a reissue application.

The Patent Examiner further asserts that it is improper to state in the declaration that the errors were due to claim language absent in the parent applicant and that the declaration must address an error in which the parent claims were too limiting, pointing out that limiting structure.

(Office Action, page 4 (emphasis added)) As discussed more fully below, this is not the case as the claims can properly be broadened in this application. Further, Rule 1.175(a)(1) allows such a reissue if the “patentee [claimed] more or less than the patentee had the right to claim in the patent. (emphasis added)”

Moreover, at all relevant times, word-for-word correspondence is not required between the reissue declaration and the actual changes made in the reissue application. *Dethmers Mfg. Co., Inc. v. Automatic Equipment Mfg Co.*, 271 F.3d 1365, 1370 (Fed. Cir. 2001). Thus, the errors identified in the substitute declaration are errors on which this reissue application can be based.

On page 4 of the Office Action, the Patent Examiner asserts that the declaration fails to state that these errors arose without any deceptive intention on the part of the applicant. (Office Action, page 4, ¶ 5) Applicants respectfully traverse. A statement as to the lack of deceptive intention on the part of the applicant is shown above at callout “D” shown on page 11 of this Response. Accordingly, the substitute declaration contains the requisite statement as to lack of deceptive intention on the part of the applicant.

Thus traversed, Applicants respectfully ask the Patent Examiner to withdraw the assertions as to the declaration being defective stated on pages 3-4 of the Office Action.

**C. Claims 10-17 And 19-35 Are Not Improperly Broadened**

On page 4 of the Office Action, the Patent Examiner asserts that the claims are being improperly broadened in a reissue application. (Office Action, page 4, ¶ 7) Applicants respectfully traverse.

A party can broaden a claim if the reissue request is filed within two years after grant. 35 U.S.C. § 251. U.S. Patent No. 5,449,956, upon which this reissue application is based, issued

March 19, 1996. The present application for reissue was filed November 11, 1997. With respect to claims 1-35 (and ignoring claims 36-64), all claims after 9 were added during the current reissue application process. Thus, its newly sought claims, filed within two years after grant, can be broader than those originally granted.<sup>1</sup>

Moreover, claims 1-30 (as then amended) were allowed on July 26, 2000 but the reissue patent never issued, for reasons unknown. On January 18, 2001, in a follow-up office status correspondence, claim 18 was deleted and various claims amended. On September 22, 2004, having heard nothing further from the Patent Examiner and with the application still pending, some claims were further amended and claims 36-64 added.

Accordingly, all claims were added to this reissue application which was filed before the expiration of the two years from issue time frame and were accordingly properly broadened. Thus traversed, Applicants respectfully ask the Patent Examiner to withdraw the assertions as to the claims being improperly broadened on page 4 of the Office Action.

**D. Rejections Under 35 USC §112**

Claims 10-17 and 19-23 stand rejected under 35 USC § 112 for use of the word “through” and other elements identified by the Patent Examiner on page 5 of the Office Action.

The word “through” used in the claims is used as, e.g., “wherein each foot of the user of the device is movable through a generally elliptical path” (Claim 10). In context, “through” in claims 10, 13, 16, 20, 24, 26, 31, 32, and 33 has been replaced with a synonymous phrase “to circumnavigate” and thus no new matter has been added.

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<sup>1</sup> Applicants respectfully note that the Patent Examiner’s reasons on page 4 are not clear. The Patent Examiner appears to assert that the declaration was sworn to by other than the assignors and not the patentee. This is incorrect. (Reissue File History Doc. 4)

With respect to the Patent Examiner's comments regarding pedal path on page 5 of the Office Action, claims 10, 13, 16, 20, 24, 26, 31, 32, and 33 claim that the pedal path is generally elliptical. In this regard, "substantially" and "having a majority" are similar.

With respect to claim 8, claim 8 has been amended per the Patent Examiner's suggestion.

With respect to claim 25, claim 25 has been amended to correct a scrivener's error and now reads "... between the frame and the right foot support."

With respect to claim 28, claim 28 has been amended to claim "on each side of the frame." This meaning is clear from the context of the limitations which state various relationships of other elements to the frame within claim 28.

In all of these amendments, no new matter was added. The amendments to the claims accordingly render the §112 rejections moot.

**E. Rejections Under 35 USC §102**

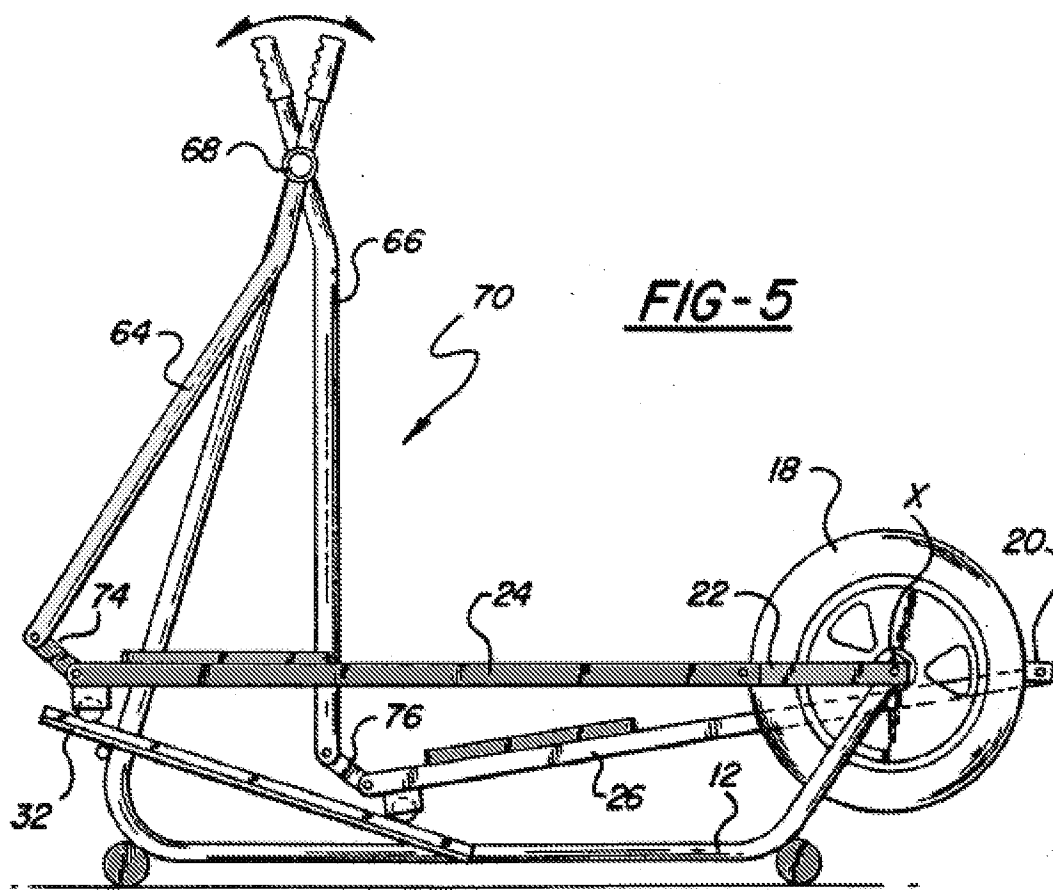
Claims 16-17, 20, 22-25, 28, 30, 33-35 stand rejected under 35 USC §102(a) and/or 35 USC §102(b) as being anticipated by US Patent 5,383,829 to Miller ("Miller I") and/or US Patent 5,242,343 to Miller ("Miller II"), which is a continuation of Miller I. Applicants respectfully traverse.

Anticipation under 35 U.S.C. § 102 requires that every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). As the disclosures in Miller I and Miller II are identical, Applicants will refer to them jointly as Miller.

**1. Miller Does Not Anticipate Claim 16**

Independent claim 16 recites first and second rigid members connected to respective first and second rocker links at a first connection distance from the common rocker pivot axis. Claim

16 further recites first and second foot supports connected to respective first and second rocker links at a relatively greater second distance from the common rocker pivot axis.



The Patent Examiner asserts that cranks (22 shown in green in Fig. 5 reproduced above), rocker links (64 shown in yellow in Fig. 5 reproduced above), rigid members (24 or 74 shown in blue in Fig. 5 reproduced above), and foot supports (shown in brown without callouts in Fig. 5 reproduced above; *see also* foot retaining pads 44 in Fig. 1 and Col. 3, lines 38-41)) are disclosed in Miller.

In the invention claimed in claim 16 of the reissue application, first and second rigid members have a first portion movably connected to their respective cranks and are rotatable together therewith about those cranks' crank axis. However, only Miller's "rigid member" foot



link 24 arguably has a first portion movably connected to a crank 22 and is rotatable together therewith about the crank axis of crank 22.

In claim 16, the claimed first and second rigid members also have a second portion movably connected to their respective rocker link at a first connection distance from the pivot axis and movable in reciprocal fashion relative to the frame. Millers' "rigid member" foot link 24 is not connected to rocker link 64; instead, connecting link 74 is connected to rocker link and "rigid member" foot link 24. Thus, the Patent Examiner would require Miller's "rigid member" foot link 24 together with connecting link 74, joined at a common pivot point, to be a first (or second) rigid member. Two members thus articulated cannot be a single rigid member under § 102 for the first or second rigid member claimed in claim 16.

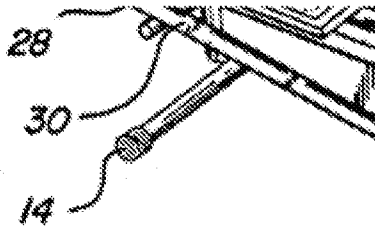
In claim 16, first and second foot supports are connected to a second location on their respective rocker links at a relatively greater second distance from the pivot axis. Miller's foot retaining pads 44 are not on a respective rocker link but are, instead, on the "rigid member" foot link 24. (*See* Fig. 1; Fig. 3; Fig. 4; Fig. 5).

Accordingly, Miller does not disclose each and every limitation of claim 16, arranged as in claim 16 and does not anticipate claim 16.

## **2. Miller Does Not Anticipate Claim 17 For Additional Reasons**

With respect to claim 17, claim 17 depends from claim 16 which, traversed above, is not anticipated by Miller. Moreover, Miller does not disclose a roller that carries the weight of a person standing on the apparatus. In Miller, the only mention of a "roller" is that "second ends 24", 26" of the foot links 24 and 26" respectively terminate in rollers 28 which engage tracks 30, 32. (Col. 3, lines 13-15; *see* Fig. 1) That to which the Patent Examiner appears to rely in Fig. 5 is unclear. If the Patent Examiner is referring to that which is illustrated in Fig. 5 (shown on page 17 of this Response in pink), these are legs 14 disposed to support the frame 12 on a floor

or other such surface, not rollers at all. (Col. 2, lines 59-62; *see also* callout 14 in the detail below from Fig. 1 (pink color added)).



DETAIL FROM MILLER FIG. 1

3. Miller Does Not Anticipate Claim 19 For Additional Reasons

With respect to claim 19, claim 19 depends from claim 16 which, traversed above, is not anticipated by Miller. Moreover, Miller's foot supports (foot retaining pads 44) are not disclosed as being pivotable.

4. Miller Does Not Anticipate Claim 20

Independent claim 20 requires at least one left and right link movably interconnected between the crank and their respective left or right foot support, wherein these links include a rigid member having a first position which rotates together with the crank about the crank axis and also having a second portion which moves in a reciprocating path. Links 64 are not interconnected between crank 22 and foot supports 24 such that links 64 include a rigid member having a first position which rotates together with crank 22 about the crank axis (which, referring to Fig. 5 reproduced on page 17 of this Response, is either at the "X" callout on that figure or the intersection of crank 22 with rigid members 24).

**5. Miller Does Not Anticipate Claims 21-23**

Claim 21 is not addressed by the Patent Examiner in the Office Action on pages 6-8. However, claim 21 depends from claim 20 which, being traversed, is not anticipated by Miller. Moreover, as discussed above, Miller does not disclose a roller that carries the weight of a person standing on the apparatus.

Claim 22 depends from claim 20 which, being traversed, is not anticipated by Miller.

Claim 23 depends from claim 20 which, being traversed, is not anticipated by Miller.

**6. Miller Does Not Anticipate Claim 24**

Independent claim 24 recites left and right foot supports that are movable through a variable path, whereas Miller discloses a fixed path machine. Miller does not disclose left and right links movably interconnected between the crank and respective left and right links, where respective left and right foot supports are movably connected to a discrete portion of their respective second links.

**7. Miller Does Not Anticipate Claims 25-30**

Claim 25 depends from claim 24 which, being traversed, is not anticipated by Miller.

Independent claim 28 recites a first rigid member connected to the frame and a second rigid member connected to the first rigid member. Claim 28 further recites a crank linked to one of the two rigid members, and a foot supported connected to the other of the rigid members.

In Miller, “rigid member” foot link 24 is movably connected to a crank 22. Crank 22 is connected to frame 12 and to “rigid member” foot link 24. Crank 22 is not connected to connecting link 74. “Rigid member” foot link 24 is also connected to connecting link 74 which is connected to rocker link 64. Thus, crank 22 cannot be both the first rigid member connected to the frame and the crank that is rotatably mounted on the frame and linked to one of the first rigid member and the second rigid member.

Additionally, the Miller members 24 and 26 are the only members connected to both the crank and respective foot supports. Moreover, the only connection between the Miller crank and the Miller rocker links is via the Miller members 24 and 26, which connections are already being recited in other parts of the claim.

Thus, Miller does not disclose a first rigid member connected to the frame and a crank linked to one of the two rigid members and, accordingly, does not anticipate claim 28.

Claim 29 depends from claim 28 which, being traversed, is not anticipated by Miller.

Claim 30 depends from claim 28 which, being traversed, is not anticipated by Miller. Moreover, claim 30 recites a substantially constant foot support orientation during exercise motion. Miller, on the other hand, shows just the opposite. (*See, e.g.*, Fig. 2a, 2b, 5).

#### **8. Miller Does Not Anticipate Claim 31**

With respect to claim 31, claim 31 claims an exercise apparatus, comprising lockable left and right cranks mounted on the frame and rotatable relative thereto about a crank axis, wherein the cranks are linked to respective assemblies in a manner that accommodates movement of the claimed foot supports to circumnavigate respective, generally ovate paths. (*See* Col. 5, lines 29-41 of the '956 Patent). Although Miller's crank 22 is indirectly connected to Millers' rigid members 64-74 (Office Action, page 7), nothing in Miller discloses that crank 22 can be locked into a position. In fact, such a lock would make Miller inoperative.

#### **F. Rejections Under 35 USC §103(a)**

Claims 33-34 stand rejected under 35 USC §103(a) as being rendered obvious by Miller in view of Breunig. Applicants respectfully traverse.

With respect to claims 33 and 34, claims 33 and 34 claim an exercise apparatus, comprising lockable left and right cranks. (*See* Col. 5, lines 29-41 of the '956 Patent). Nothing in Miller discloses that crank 22 can be locked into a position or otherwise renders a lockable

crank as claimed in claims 33 or 34 obvious. In fact, such a lock would make Miller inoperative. Thus, Miller does not render claims 33 or 34 obvious in view of the cited prior art.

### **III. CONCLUSION**

In view of the foregoing, acceptance for issue of all pending claims is respectfully requested.

Respectfully submitted,

10/16/2007

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